

### **REMARKS**

Entry of the foregoing, reexamination and further and favorable reconsideration of the subject application in light of the following remarks, pursuant to and consistent with 37 C.F.R. § 1.112, are respectfully requested.

The Office Action Summary correctly indicates that claims 1-3, 5 and 9-36 are pending in the application and stand rejected.

Claim 1 has been amended. Support for the amendment to claim 1 can be found in the specification on at least page 3.

No prohibited new matter has been introduced by way of the above amendments. Applicants reserve the right to file a continuation or divisional application on subject matter canceled by way of this Amendment.

#### **Rejections under 35 U.S.C. § 112**

Claims 1-3, 9-11, 15-22 and 26-33 stand rejected under 35 U.S.C. § 112 as allegedly indefinite for reciting "one or more active compounds directed against animal pests." The rejection is traversed.

The Office has correctly noted that the terminology used in the claim is defined in the specification. In addition to the definitions cited, numerous examples of active compounds directed against animal pests have been provided. The definitions and examples are consistent with the normal and ordinary meaning that persons of ordinary skill would apply to the claim terms. Applicants respectfully submit that persons of ordinary skill in the art would understand and recognize what is meant by active compounds directed against animal pests so that the metes and bounds of the claims

would be clear to those persons. Nevertheless, without acceding to the allegation of the Office, claim 1 has been amended to recite that the active compounds directed against animal pests are selected from among insecticides, acaricides and sterilizing agents.

Applicants submit that the basis of the rejection cannot reasonably be alleged against the claims as amended.

### **Rejections under 35 U.S.C. § 103**

Claims 1-3, 5, and 9-36 stand rejected under 35 U.S.C. § 103 as allegedly unpatentable over U.S. Patent No. 3,846,557 (Mulla et al.), Lloyd et al. (Management of Fruit Flies in the Pacific – ACIAR Proceedings, 1997) and German Patent Application DE 197 49 683 A1 (Baumgaertner), as purportedly evidenced by applicant's specification.

The prior art fails to establish a proper prima facie case of obviousness. To establish a prima facie case of obviousness, there must be some rational reason to modify the references or to combine reference teachings to arrive at the claimed combination. It is impermissible to first ascertain factually what applicants did and then view the prior art in such a manner as to select from the random facts of that art only those which may be modified and then utilized to reconstruct applicant's invention from such prior art. *See, e.g., Interconnect Planning Corp. v. Feil*, 227 U.S.P.Q. 543, 550 (Fed. Cir. 1985); *see also, In re Shuman*, 150 U.S.P.Q. 54, 57 (C.C.P.A. 1966). An analysis of obviousness of a claimed combination must include consideration of the results achieved by that combination. *The Gillette Co. v. S.C. Johnson & Son Inc.*, 16 USPQ2d 1923, 1928 (Fed. Cir. 1990). Federal Circuit has held that the particular

results achieved by the new combination is must be considered. *Id.* (citing *Interconnect Planning Corporation v. Feil*, 227 U.S.P.Q. 543, 551 (Fed. Cir 1985)).

Mulla et al. teach a dried bait comprising fermented or decayed protein which can be mixed with an insecticide. Lloyd et al. teach a bait for fruit flies made from brewery yeast autolysate. The combination of Mulla et al. and Lloyd et al. does not suggest a combination comprising synthetic silicic acids as recited in the present claims.

Separately, Baumgaertner described an insecticide made from a combination of silicic-acid and/ or silicate and a baiting substance which may be yeast. The Office cites the abstract and Baumgaertner at page 1, line 15. It should be noted that the paragraph at page 1, line 15 of Baumgaertner indicates that in the prior art silica was not used as an active ingredient. The Office has alleged that it would be *prima facie* obvious to combine the compositions of Mulla et al. and Lloyd et al. with Baumgaertner. However, the Office has apparently overlooked the fact that Baumgaertner read as a whole teaches away from the proposed combination.

The combination proposed by the Office would be contrary to the stated objective of Baumgaertner . The stated object of Baumgaertner was to provide a safe alternative to conventional chemical insecticides.

At page 1, lines 27-32 Baumgaertner stated

Kieselsäuren und Silikate sind physiologisch und ökologisch unbedenklich, sie sind daher prinzipiell hervorragend zur Bekämpfung von Schädlingen im Haushaltsbereich geeignet. Dazu müssen sie jedoch gezielter wirken können, d. h. ihre Wirkung darf nicht nur auf einer zufälligen Berührung der zu bekämpfenden Insekten mit der Kieselsäure beruhen.

Aufgabe der Erfindung ist es, ein insektizides Mittel auf der Basis von Kieselsäure oder Silikaten bereitzustellen, das im Haushaltsbereich einsetzbar

ist, gezielt wirkt, lokal eng begrenzt ausgebracht werden kann und dennoch hochwirksam ist.

which translates essentially as

Silicas and silicates are physiologically and ecologically sound, they are therefore in principle suited for controlling pests in households. To act more selectively, however, their action must not only be based on incidental contact with the insects to be controlled by the silica.

The object of the invention, therefore, is to provide an insecticidal composition based on silica or silicates, which can be used in the confines of a household, yet is highly effective.

That is, the object of Baumgaertner was to provide an insecticidal composition suitable for use in the home which was free from conventional insecticides that are unsafe or undesirable for use in the home. Baumgaertner met this objective by providing a composition comprising silicas in combination with a baiting substance. It would defeat the purpose of Baumgaertner to include that which he sought to provide an alternative to, i.e. other chemical active ingredients such as insecticides, acaricides, and sterilizing agents. It is well established that if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

It should be noted that this point was understood and explained by the examiner who prepared the International Preliminary Examination Report (IPER). The examiner preparing the IPER considered both Lloyd et al. and Baumgaertner during the international phase of the present application and explained why Lloyd et al. and Baumgaertner would not have been combined. The present Examiner's attention is

directed to the International Preliminary Examination Report, which was submitted with the application, for an independent discussion of this issue.

Indeed, the Office has not identified any sound scientific reason for combining the references as proposed. There is no indication in the prior art to suggest that the combination would be advantageous. There is no suggestion in the art that combining the materials used in the different compositions would even provide a simple additive benefit, let alone the improvement in effectiveness that the inventors have discovered. Evidence of the improvements provided by the invention are found only in the Applicants' disclosure. Consideration of the results achieved by the claimed combination must lead to a finding that the invention was not obvious. *See, e.g., The Gillette Co. v. S.C. Johnson & Son Inc.*, 16 USPQ2d 1923, 1928 (Fed. Cir. 1990). In the absence of any appreciation of the benefits of the combination in the prior art, there would have been no reason for a person of ordinary skill in the art to go to the expense of making the claimed combination.

Thus, in the absence of a sound scientific basis for the proposed combination, the prior art does not provide sufficient basis to support a prima facie finding of obviousness. Accordingly, withdrawal of the rejection is appropriate and respectfully requested.

### **CONCLUSION**

In view of the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order. Such action is earnestly solicited.

In the event that there are any questions relating to this application, it would be appreciated if the Examiner would telephone the undersigned concerning such questions so that prosecution of this application may be expedited.

The Director is hereby authorized to charge any appropriate fees that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800.

Respectfully submitted,  
BUCHANAN INGERSOLL & ROONEY PC

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